

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL CHEN

Appeal No. 1998-2841
Application No. 08/463,282

ON BRIEF

Before KRASS, FLEMING, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The invention is directed to a remote control security system for an automobile; in particular, a remote control transmitter and receiver. Claim 1 is reproduced below.

1. In a remote control security system for an automobile, comprising a remote control unit, a receiving unit, and an operation unit connected to said receiving unit; said remote control unit emitting a combination code signal and said receiving unit receiving said combination code signal so as to control operation of said security system:

wherein said remote control unit includes a keyboard, an encoder and a signal emitter; said encoder produces a combination code corresponding to said combination code signal according to a signal from said keyboard, and said combination code is transmitted by said signal emitter;

wherein said receiving unit includes a receiver and a decoder; said receiver receiving the combination code signal sent by said emitting means¹ of said remote control unit and said decoder including means for comparing said a received combination code decoded from said combination code signal with a combination code produced by said decoder; and

wherein if the received combination code matches the combination code produced by the decoder, a control signal is transmitted to said operation unit to control operation of the security system,

the improvement wherein the combination code comprises a fixed combination code and two variable remedy codes, and said encoder and decoder each includes means for sequentially varying a first of the remedy codes once each time a key on said keyboard is pressed, and for sequentially varying a second of the remedy codes constantly between a time that said key is pressed and a time that said key is released.

¹ Since there is no "emitting means" previously set forth in the claim, the recitation should be changed to "said signal emitter" to avoid a lack of proper antecedent.

Claims 1-3 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to provide an enabling disclosure.²

We refer to the Final Rejection (Paper No. 4) and the Examiner's Answer (Paper No. 16) for a statement of the examiner's position and to the Brief (Paper No. 15) and the Reply Brief (Paper No. 17) for appellant's position with respect to the claims which stand rejected.

OPINION

Before turning to the instant rejection of claims 1-3 under 35 U.S.C. § 112, first paragraph, we briefly review the requirements of the statute with respect to providing an enabling disclosure.

The first paragraph of 35 U.S.C. 112 requires, inter alia, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without 'undue experimentation.' In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is 'undue.' Id. at 736-37, 8 USPQ2d at 1404.

In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

² The Final Rejection, at page 2, also sets forth a rejection of claim 3 under 35 U.S.C. § 112, second paragraph. The rejection for indefiniteness has been withdrawn by the examiner upon entry of the amendment after final filed April 22, 1997 (Paper No. 5). However, the appendix of claims submitted with the Brief does not reflect the noted amendment to claim 3.

The question is whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention; the specification need not disclose what is well known in the art. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984) (citing In re Myers, 410 F.2d 420, 161 USPQ 668 (CCPA 1969)). "A patent need not teach, and preferably omits, what is well known in the art." Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987). "Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962).

The examiner bears the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the claims is thought to be not adequately enabled by the description of the invention provided in the specification. If that burden is met, the burden then shifts to the applicant to provide proof that the specification is indeed enabling. In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The statement of the rejection (Final Rejection, pages 1-2; Answer, page 6) does little to meet the initial burden. The rejection merely alleges that certain aspects of the disclosure are not clearly understood, which, without more, does not show lack of enablement. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual

considerations.” In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The factors to be considered in determining whether a disclosure would require undue experimentation include:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Wands, 858 F.2d at 737, 8 USPQ2d at 1404.

The statement of the rejection is thus plainly deficient.³ In our view, other factors -- not addressed in the rejection -- which are relevant to the enablement analysis outweigh any facts relied upon by the examiner.

As a general consideration, the level of predictability in the mechanical and electrical arts is recognized as being relatively high. See, e.g., In re Hogan, 559 F.2d 595, 606, 194 USPQ 527, 537-38 (CCPA 1977) (taking notice of the high level of predictability in mechanical or electrical environments and the lower level of predictability expected in chemical reactions and physiological activity).

³ We note that, consistent with the law of our reviewing court, Office policy is to consider all the relevant factors when making a rejection for lack of enablement. “The examiner’s analysis must consider all the evidence related to each of these [In re Wands] factors, and any conclusion of nonenablement must be based on the evidence as a whole.” Manual of Patent Examining Procedure § 2164.01(a), Seventh Edition, Rev. 1 (Feb. 2000).

In the Brief and Reply Brief, appellant refers to several U.S. patents which serve as extrinsic evidence of both the state of the prior art and the relative skill of those in the art.⁴ Yet, the Answer does not address the evidence provided by appellant in rebuttal to the rejection. Of particular interest is U.S. Patent 5,103,221 (Memmola), which is listed as “prior art of record relied upon in the rejection of claims under appeal” (Answer, page 5), but is not otherwise mentioned in the rejection.

Memmola discloses a remote-control security system, suitable for use with an automobile, which includes a remote control unit and a receiving unit (Fig. 1). The remote control unit includes a keyboard, an encoder, and a signal emitter. The receiving unit includes a decoder. As described in particular at columns 8 through 13, Memmola discloses a code comprising a base, or “starting,” security code. Each time a keyboard switch is activated, an algorithm determines modification of the present code. The remote control unit encodes a signal which includes the base code, the modified code, and the channel code (which is a unique switch code). The encoded signal may be transmitted to the receiving unit, which decodes the received signal and compares the signal to the

⁴ Enablement is determined as of the filing date of the application. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). Appellant refers, at least on page 16 of the Brief, to U.S. Patent 5,517,187 (Bruwer), issued May 14, 1996. However, the relevant date for enablement is the instant filing date of June 5, 1995. Bruwer’s disclosure of Bruwer’s invention cannot be used as evidence relating to what the artisan knew in June, 1995. Later publications may, in some circumstances, be used as evidence to show the state of the art at an earlier time. See, e.g., Hogan, 559 F.2d at 605 n.17, 194 USPQ at 537 n.17 (noting use of later publications as evidence of the state of art existing on the filing date of an application). Here, however, appellant refers to Bruwer’s own invention, of which the artisan was not necessarily aware in June, 1995.

expected base code and the modified code as predicted by the algorithm. If there is a match between the base code and the modified code between the remote unit and the receiving unit, then the receiving unit generates an actuating signal that is dependent on the received channel code.

In view of Memmola's disclosure, we find that the level of ordinary skill in the art was relatively high, and the state of the prior art could not have been far removed from the instantly claimed invention. Further, at least in view of the claim format chosen by appellant, the instant claims are relatively narrow in scope. Independent claim 1 is drafted in the well-known Jepson format; everything prior to the final portion, which begins with "the improvement wherein," is presumed to be descriptive of the prior art. We interpret the claim as setting forth elements which are conventional or known in the portion preceding "the improvement wherein," with the conventional or known elements forming part of the combination. See, e.g., Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

The scope of the claims is limited, accordingly, as being an improvement of the prior art described. Consistent with the presumption that is implicit in the claims, it appears that Memmola discloses all that is claimed in claim 1 but for the improvement that, rather than a code comprised of a fixed code and a single variable code, the code further

comprises a code which sequentially varies between a time that a key is pressed and a time that the key is released.⁵

In light of the evidence before us, the questions posed by the examiner are misplaced. For example, it matters little, contrary to the implication on page 6 of the Answer, whether the additional codes are generated by an algorithm, are pre-stored (i.e., tabular), or are the product of a random number generator. Using any of the methods would have been within the immediate understanding of the ordinary artisan. The instant claims, as the disclosure, are not specific as to how the codes may be encoded and decoded. However, to practice the full scope of the claimed invention, we find that the details of implementation would not have required undue experimentation. An applicant need not, and preferably does not, disclose what is already well known in the art.

In this regard we agree with appellant that the rejection appears to wrongly place emphasis on what the original specification failed to disclose. Determining what the specification does not disclose is, at best, merely a first step in determining whether the claimed invention is enabled. The examiner refers to tools in the prior art (e.g., to “stop bits” and “headers” at the bottom of page 10 of the Answer) which may, or may not, be used in implementation of the invention. The inquiry should be directed to whether the lack

⁵ The significance of the language “remedy codes” is not apparent, and even appellant’s counsel appears to not understand the import of the recitation (Brief, page 10). The rejection does not fault the language “remedy codes” per se. We do not consider the modifier “remedy” to be fatal to an understanding of the subject matter, and interpret “remedy codes” as simply meaning codes that are distinct from the “fixed combination code,” and which are as further defined by the claim recitations.

Appeal No. 1998-2841
Application No. 08/463,282

of description of those things not detailed in the specification would prevent the artisan from making and using the invention claimed.

Upon weighing the factual considerations before us, we do not agree that the instant disclosure fails to teach the artisan how to make and use the claimed invention. At least for the reason that the rejection fails to consider the evidence as a whole, we do not sustain the rejection of claims 1-3 under 35 U.S.C. § 112, first paragraph.

CONCLUSION

The rejection of claims 1-3 is reversed.

Appeal No. 1998-2841
Application No. 08/463,282

REVERSED

ERROL A. KRASS
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 1998-2841
Application No. 08/463,282

BACON AND THOMAS
625 SLATERS LANE
4TH FLOOR
ALEXANDRIA , VA 22314